

R E M A R K S

Claims 1-18 are pending in the application. Claim 1 has been amended.

It is to be noted that the Travel News Weekly is an electronic publication; hence, the copies being submitted are true and accurate copies as printed from the screen of the electronic publication.

Examiner rejected claims 1-18 on the basis of. 35 U.S.C? § 102(f); and 35 U.S.C. § 103

APPLICANTS REMARKS IN OPPOSITION TO EXAMINER'S REJECTION UNDER 35 U.S.C. § 102(f)

Examiner's rejection under 35 U.S.C. § 102(f) is that the published disclosures by ARC show that Applicant did not invent the claimed invention.. Accordingly it is appropriate to review the published disclosures as made by ARC. Examiner credits ARC with the following summary of disclosures

1. In 1999 ARC discussed eliminating the requirement of storing hard copies or microfiche of agent coupons.
2. On Sept 29, 1999 it was disclosed that ARC was looking into the possibility of eliminating the requirement for agent retention of paper agent coupons, with the ultimate goal being to have a master storage database and that ARC would soon allow the storage of agent coupons on an optical disc.
3. On Oct 27, 1999 a draft text was presented approving various media for electronic and optical storage of agent sales reports and supporting documents.
4. Travel Weekly on Nov, 1, 1999 reported ARC is considering to

allow agents to keep their own electronic records for agent coupon storage.

5. The revised Agent's Handbook allowed agents to maintain the required documents on microfiche or on an optical storage medium using WORM technology.

6. In a Nov2, 2000, meeting it was noted that in June 2000 ARC announced that agents can print agent coupon on non-accountable paper stock or capture the coupon data on a CD, DVD etc. and that the agents now have the option to pursue their own agent storage coupon solutions.

While the above comprises an accurate restatement of parts of the documents cited and provided by Applicant, the interpretation and focus are misplaced as regards the present office action, thereby leading to an erroneous conclusion.

It is respectfully submitted that the ARC disclosures provide that the electronic storage discussed and approved by ARC are that travel agents are allowed to electronically store *the images* of the of the agent coupons on optical discs and to electronically store *the data* associated with *sales of airline tickets*. When the disclosures of ARC are viewed in accordance with this distinction, the conclusion is that ARC's disclosures do not disclose Applicant's claimed invention and that Applicant is indeed the inventor.

In support of Applicant's argument the following is submitted:

In the 1995 Agents' Handbook, Section 70.0 required copies of agent coupons be stored on paper or microfiche or microfilm—i.e. an optical image of the agent coupons.

In the September 29, 1999 meeting it was stated that ARC was looking into the possibility of eliminating the requirement for agent retention of paper agent coupons and that ARC would soon be allowing agencies to store these agent coupons on optical disc rather than paper. Again, the proposal being for an image of the agent coupons, and not data from the agent coupons.

In the October 27 1999 meeting, ARC was asked to allow storage of agents' documents in formats other than microfiche/film or paper. ARC announced that the matter had been fully researched and ARC approved alternative means of electronic storage. An updated draft of section 70.0 of the Agents Handbook entitled Storage of Agents Sales Reports and Supporting Documents and Sales Summaries on Microfiche/Microfilm or other Optical Storage Media was reviewed with the members. Thus, the revised section 70.0 optical storage of sales reports and supporting documents and sales summaries on an optical disc, i.e. sales data and not agent coupons.

In the Travel news weekly dated 5/31/2000, ARC president David Collins is quoted as stating "Effective immediately, these agencies may print the agent's coupons on plain paper or capture the image on optical media, such as a CD-ROM.

In the Travel news weekly dated 6/20/2000, Allan Muten, ARC corporate communications director stated " If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."

In the Travel news weekly dated 7/6/2000, it is stated that “ARC previously announced that agents who report sales electronically have the option of printing the agent’s coupons of each ticket on non-accountable paper or capturing the image on optical storage media , effective immediately.” In the same article of the Travel News Weekly, it was stated “In response to questions after the new policy was announced, ARC said it can give some advice but does not ‘provide the tools or systems’ to switch agent’s coupons from accountable stock. Translation: It’s up to the agents to figure out how to do it.”

In the Sept 15, 2000 meeting, it was disclosed that ARC came out with agents not having to print out agent coupons and ARC asked to see if any vendors had the capability of optically storing agent coupon information, i.e. optically storing an image of the coupon

In the November 2, 2000 meeting ARC announced that as of June 7, 2000 can now print agent coupons on non-accountable stock or capture the coupon data on an optical media (i.e. CD-ROM, DVD etc.) And that Agents now have the option to pursue their own agent coupon storage solutions. Thus, the optical media storage that was allowed was for the storage of agent coupons themselves.

That ARC was still requiring the storage of images of the agent coupons is further reflected in the approval given to Applicant on January 19, 2001. In the January 19, 2001 document, ARC stated “The agent coupons can be printed on demand and it is a facsimile of the agent coupon (I will fax you both a copy of the printed agent coupon.)” (Emphasis in the original) Thus, ARC always maintained the requirement of the storage of an exact image of the agent coupon on an optical disc and the cited ARC

references disclose this requirement. Applicant's invention however, does not store the agent coupon image on an optical disc contrary to the disclosures by ARC, but was none the less approved by ARC and therefore comprises the reason for the emphasis by ARC on the aspect that Applicant's invention produces a facsimile of the agent coupon. . Accordingly, the disclosures by Arc teach away from Applicant's invention

In order to further evaluate Examiner's first rejection, the case law must be examined as to the correct test in applying 35U.S.C. §102(f).

The primary meaning of the word 'invention' in the Patent Act unquestionably refers to the inventor's conception rather than to a physical embodiment of that idea, *Pfaff v. Wells Electronics, Inc.* 525 U.S. 55 48 USPQ2d 1641 (1998).

"Conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." *FilmTec Corp. v. Hydranautics*, 982 F2d. 1527, 25 USPQ2d 1241 (Fed. Cir. 1992)

The word conception means that the inventor disclosed to others a completed thought in such clear terms as to enable those skilled in the art to make the invention., *Coleman V. Dines*, 754 F.3d 1449 USPQ 193 (Fed. Cir. 1985).

In *Gambro Lundia AB v. Baxter Healthcare Corp.* 110 F.3d 1573, 42 U.S.P.Q.2d 1378 (CAFC 1997), the court said "the correct standard for derivation under 35 U.S.C. § 102 (f) is whether a communication from another enabled one of ordinary skill to make the patented invention" and

not “only so much of the invention as would have made it obvious to one of ordinary skill in the art.”

In accordance with the above, in order to sustain examiner’s rejection it must be shown that the ARC disclosures were complete, clear, definite and operative so as enable one of ordinary skill to make the invention. As shown above, ARC’s disclosures revealed a system whereby the coupon image itself had to be stored on an optical disc. Applicant’s invention stores the data from the agent coupon and provides a method for reconstituting the data into an image of the coupon. Thus, ARC’s disclosures are not a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *FilmTec Corp. v. Hydranautics*. Further, the communications from ARC are not sufficient to enable one of ordinary skill to make Applicant’s invention because of the significant differences between the method of ARC and the method of Applicant. In other words, ARC’s disclosures would not result in Applicant’s invention regardless of the skill of the person. Therefore the test as per *Gambro Lundia AB v. Baxter Healthcare Corp* is not met by ARC’s disclosures.

Even more, as reported in the 6/7/2000, ARC does not “provide the tools or systems” (the full quote being stated above). If the disclosures of ARC comprised a complete conception of applicant’s invention, ARC simply had to refer the questioner to the disclosures by ARC. The fact that a person of ordinary skill was not able to figure out how to implement the new policy of ARC is shown by the very question of the travel agent. If the method to implement ARC’s new policy was obvious, the question did not need to be asked. But again, ARC’s new policy is to capture the image of the agent coupon and not the data. Even here ARC believed its prior

disclosures did not provide an agent with the knowledge to capture the coupon image on an optical disc, let alone the knowledge to store the data from which an image can be produced, i.e. Applicant's claimed invention.

APPLICANT'S REMARKS IN OPPOSITION TO
EXAMINER'S REJECTION UNDER 35 U.S.C. § 103

Examiner rejected claims 1-18 under section 103 over Freides et al in view of Industry Agents' Handbook, Section 70.0 (2000 Ed.).

Applicant disagrees with Examiner's restatement of the Freides et al reference in that Freides et al is concerned with generating an airline ticket and not an agent coupon. Also, there is no verbiage in Freides regarding generating coupon data simultaneously with the printing of an airline ticket. The procedure in the industry per the IAH is to generate an actual coupon, i.e. an image, not data. Thus, the combination of Freides et al and the IAH suffers from the same defect as the disclosures by ARC and Applicant's invention would not be obvious under 35 U.S.C. § 103. Even further, Freides et al discloses that the image of the smart card is stored (Col. 5, lines 44-48) which is the same requirement of ARC as reflected in the IAH. Whether or not the electronically stored documents and a PC printer are available to an ARC representative at the storage site is not relevant because, again, the image of the coupon is stored. The examiner is again referred to the January 19, 2001 letter from ARC approving Applicant's invention where it is stated "The agent coupons can be printed on demand and it is a facsimile of the agent coupon" as meeting the requirement for storing an image of the coupon. The emphasis ARC placed on the ability of Applicant's invention to produce a facsimile of the coupon clearly shows

that Applicant's method was not contemplated by ARC and certainly ARC can be considered to be more than one of ordinary skill

APPLICANT'S REMARKS REGARDING OTHER GROUNDS
OF REJECTION AND CITED PRIOR ART

In rejecting claims 2-4 the Examiner admits that the IAH does not accept the storage of coupon data on a hard drive (because an image is not stored). Applicant's invention stores the data on a hard drive and then provides for the printing of an image of the coupon. Is this obvious? ARC did not think so. ARC was engaged in the go electronic development for some three (3) years and did not conceive of Applicant's invention, and when Applicant's method was disclosed to ARC, ARC then saw the light-in hindsight (see the emphasis supplied by ARC in the letter of January 19, 2001 approving Applicant's method). No citation of authority is needed to show that hindsight is not a basis for a 103 rejection.

Inasmuch as Applicant submits and has provided a showing that once amended claim 1 is patentable, any claim depending from an allowable claim is also patentable regardless of an issue of the obviousness of the dependent claim. It is therefore submitted that all dependent claims 2-18 are patentable and Examiner's basis of rejection are moot, because they each depend from a patentable claim. However, Applicant disagrees with the Examiner's basis of rejection of dependent claims 2-18 and reserves the right to further respond to the 103 rejection of claims 2-18 if the same is deemed necessary or appropriate.

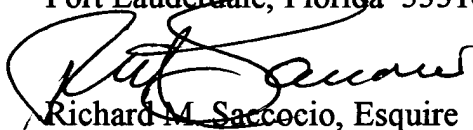
Applicant acknowledges the prior art made of record by the Examiner and submits that even if the same were relied upon, they would not anticipate or render obvious Applicant's claimed invention.

CONCLUSION

Having fully responded to the office action of May 1, 2003, it is submitted that the application is in a form for allowance, which action is respectfully requested.

Respectively submitted,

Richard M. Saccocio, P.A.
100 Southeast 12th Street
Fort Lauderdale, Florida 33316

A handwritten signature in black ink, appearing to read "R. Saccocio", is written over the printed name.

Richard M. Saccocio, Esquire
Registration No. 26,800
Tele: (954) 764-8003
Fax: (954) 764-6141